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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT PAPER NUMBER

1772

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,562

Applicant(s)

O'CONNOR, LAWRENCE J.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/03 6/04, 1&3/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 – 41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 85 of copending Application No. 10/821,202. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards coverings for use on an exterior surface made with fibrous layers, moldable layers and release sheets covering the back surface of the moldable layer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 – 41 are directed to an invention not patentably distinct from claims 1 – 85 of commonly assigned Application 10/821,202. Specifically, both articles contain coverings for use

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on an exterior surface are made with fibrous layers, moldable layers and release sheets covering the back surface of the moldable layer.

3. Claims 1 – 41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 23 of copending Application No. 10/880,607. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards surface coverings made with fibrous layers or carpet layers, moldable layers or underlayment layers and release sheets covering the back surface of the moldable layer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 – 41 are directed to an invention not patentably distinct from claims 1 - 23 of commonly assigned Application 10/880,607. Specifically, both articles contain coverings made with fibrous layers or carpet layers, moldable layers or underlayment layers and release sheets covering the back surface of the moldable layer.

4. Claims 1 – 41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 21 of copending Application No. 11/023,412. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards coverings for use on an

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exterior surface that are made with fibrous layers, moldable layers and release sheets covering the back surface of the moldable layer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 – 41 are directed to an invention not patentably distinct from claims 1 – 21 of commonly assigned Application 11/023,412. Specifically, both articles contain coverings for use on an exterior surface are made with fibrous layers, moldable layers and release sheets covering the back surface of the moldable layer.

5. Claims 1 – 41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 19 of copending Application No. 11/023,413. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards coverings for use on an exterior surface that are made with fibrous layers, adhesive layers and release sheets covering the back surface of the moldable layer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 – 41 are directed to an invention not patentably distinct from claims 1 – 19 of commonly assigned Application 11/023,413. Specifically, both articles contain coverings for use

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on an exterior surface are made with fibrous layers, adhesive layers and release sheets covering the back surface of the moldable layer.

6. Claims 1 – 41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 20 of copending Application No. 11/034,255. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards coverings for use on an exterior surface that are made with fibrous layers, adhesive layers and release sheets covering the back surface of the moldable layer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 – 41 are directed to an invention not patentably distinct from claims 1 – 20 of commonly assigned Application 11/034,255. Specifically, both articles contain coverings for use on an exterior surface are made with fibrous layers, adhesive layers and release sheets covering the back surface of the moldable layer.

Priority

7. It is noted that this application appears to claim subject matter disclosed in prior Application No. 60/491,292, filed 7/31/03. The priority to this application is incorrect as there is no common or inventor or assignee. The Examiner believes that number for the Provisional Application should be 60/491,252. This error in filing needs to be corrected.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 15 – 23, 30 – 32, 35, 36 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Friedlander et al. (USPN 4,695,493).

Friedlander et al. disclose a elongate composite strip in the form of a supply roll (Column 6, lines 64 – 68) comprising a layer of fibrous floor covering material having a fibrous front and back surface (Figure 1, #4, 6 and 8; Column 4, lines 6 – 7), a mold layer formed of hot melt adhesive (Column 3, lines 1 – 5) covering the entire back surface of the strip having a bottom surface with an adhesive property for attaching the fibrous floor covering material (Figure 1, Adhesive layer) with a thickness of 1 to 20 mil (Column 3, lines 29 – 31) and a release sheet on the attachment layer which is arranged to be removed for the attachment of the attachment layer to the surface (Figure 1, #20; Column 2, lines 55 – 57), wherein the composite has a predetermined length and width, the width being less than the length (Column 6, lines 65 – 68) in claims 15 – 19, 23, 30, 32 and 41. With regard to claims 22 and 35, the composite strip is arranged to provide no resistance to bending of the fibrous layer and the attachment layer from a rolled condition to a flat condition for attachment to a generally flat surface and to by follow gravity generally any undulations in the flat surface (Column 4, lines 24 – 31). The moldable

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layer is formed of hot melt adhesive (Column 3, lines 1 – 3) having a thickness of 1 to 20 mil (Column 3, lines 28 – 30), while the fibrous layer is mat formed by needle punching, tufted, woven or carpet (Column 4, lines 62 – 68) and the release sheet is a silicon-coated material (Column 5, lines 1 – 6) as in claims 20, 21, 31 and 36.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1 – 6, 13, 14, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedlander et al. in view of Bell et al. (USPN 5,204,155).

Friedlander et al. disclose a elongate composite strip in the form of a supply roll (Column 6, lines 64 – 68) comprising a layer of fibrous floor covering material having a fibrous front and back surface (Figure 1, #4, 6 and 8; Column 4, lines 6 – 7), an adhesive layer adhesively attached to the back surface of the fibrous layer (Figure 1, #16), an impermeable foil barrier layer which is secured to the back surface of the fibrous layer by the adhesive layer so as to substantially cover the back surface of the fibrous layer (Figure 1, #12), a water impermeable, non-absorbent and incompressible in the thickness direction attachment layer or moldable layer covering the foil barrier layer having a bottom surface with an adhesive property for attaching the fibrous floor covering material and the foil barrier layer to a support surface (Figure 1, Adhesive layer)

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and a release sheet on the attachment layer which is arranged to be removed for the attachment of the attachment layer to the surface (Figure 1, #20; Column 2, lines 55 – 57), wherein the foil barrier layer has a thickness less than 0.001 inch (Column 2, lines 45 – 48). The barrier layer is encapsulated between the adhesive layer and the attachment layer by an interconnection of the edges of the adhesive layer and the attachment at the edges of the barrier layer (Figure 1, #16, #12 and Adhesive Layer; Column 3, lines 21 – 40). The composite strip is arranged to provide no resistance to bending of the fibrous layer and the attachment layer from a rolled condition to a flat condition for attachment to a generally flat surface and to by follow gravity generally any undulations in the flat surface (Column 4, lines 24 – 31). The moldable layer is formed of hot melt adhesive (Column 3, lines 1 – 3) having a thickness of 1 to 20 mil (Column 3, lines 28 – 30), while the fibrous layer is mat formed by needle punching, tufted, woven or carpet (Column , lines 62 – 68) and the release sheet is a silicon-coated material (Column 5, lines 1 – 6).

However, Friedlander et al. fail to disclose the moldable layer being applied at a coating weight of between about 185 and 465 grams per square meter, the attachment layer having a coating weight per unit area of greater than 185 grams/sq meter or 300 grams/sq meter and the total material applied in the attachment layer and in between the barrier layer and the layer of fibrous floor covering material having a weight per unit area of greater than 300 grams/ sq meter, 400 grams/ sq meter or 600 grams/ sq meter.

Bell et al. teach the moldable layer being applied at a coating weight of between about 185 and 600 grams per square meter (Column 4, lines 4 – 15), the attachment layer having a coating weight per unit area of greater than 185 grams/sq meter or 300 grams/sq meter (Column

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4, lines 4 – 15) and the total material applied in the attachment layer and in between the barrier layer and the layer of fibrous floor covering material having a weight per unit area of greater than 300 grams/ sq meter, 400 grams/ sq meter or 600 grams/ sq meter (Column 6, lines 35 – 44) in floor covering made with carpet (Column 1, lines 50 – 52) for the purpose of having a flooring that is sufficient to distribute the compressive weight of objects placed on the face of the floor surface covering (Column 4, lines 4 – 8).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the coating weights of the moldable layer and the attachment layers in Friedlander et al. in order to have having a flooring that is sufficient to distribute the compressive weight of objects placed on the face of the floor surface covering as taught by Bell et al.

12. Claims 7, 8, 12, 24, 25, 29 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedlander et al. in view of Kalwara et al. (USPN 6,426,129).

Friedlander et al. discloses a covering for an external surface as shown above but fails to disclose the barrier layer having a first width and the fibrous layer having a second width, wherein the second width is greater than the first width, the predetermined width being less than 12 inches, the predetermined length being at least 25 feet, and the release sheet having free edges that extend beyond the fibrous layer and moldable layer to provide a grasping surface at the edges of the composite covering strip.

Kalwara et al. teach a covering for an external surface wherein the barrier layer having a first width and the fibrous layer having a second width, wherein the second width is greater than the first width (Figure 2, #12 and 14), the composite strip being elongated with a predetermined length and having a predetermined width, the predetermined width being less than the predetermined length (Column 5, lines 7 – 10), the predetermined width being less than 12 inches (Column 5, lines 9), the predetermined length being at least 25 feet (Column 5, line 8), and the release sheet having free edges that extend beyond the fibrous layer and moldable layer to provide a grasping surface at the edges of the composite covering strip (Figure 2, #20) for the purpose of having a release liner that is easily to disengage from the tacky surface of the adhesive layer (Column 5, lines 39 – 46).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the desired lengths and widths of materials in the composite to cover an exterior surface in Friedlander et al. in order to have a release liner that is easily to disengage from the tacky surface of the adhesive layer as taught by Kalwara et al.

13. Claims 9 – 11, 27, 28 and 37 – 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedlander et al. in view of Tajima et al. (USPN 3,937,640).

Friedlander et al. discloses a covering for an external surface as shown above but fails to disclose the release sheet has a separate central release sheet, the release sheet is formed with a plurality of strips or three separably removable strips with one on each edge and one in the

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center, the middle strip overlapping the edge strips, the width of one strip being less than at least one of the strips.

Tajima et al. teach a covering for an external surface wherein the release sheet has a separate central release sheet, the release sheet is formed with a plurality of strips or three separably removable strips with one on each edge and one in the center, the middle strip overlapping the edge strips, the width of one strip being less than at least one of the strips (Figure 3A and 3B, #14; Column 7, lines (Column 7, lines 49 – 58) for the purpose of rendering the application of the covering for an external surface easier (Column 7, lines 57 – 58).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the various methods of applying a release sheet to the back surface of an external covering in Friedlander et al. in order to render the application of the covering for an external surface easier as taught by Tajima et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer
Examiner
Art Unit 1772

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HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

9/19/05